

R E M A R K S

- Claims **2-10 and 18-38** are currently pending;
- Claims **2-10 and 18-38** stand rejected;
- Claims **39 – 48**, upon entry of this Amendment (which is respectfully requested), will be added;
- Since this submission is being submitted subsequent to a Final Office Action, it is being submitted along with an RCE in conformance with 37 C.F.R. 1.114, to ensure consideration of the submission.

1. Claim Rejections – 35 USC §112

Claims **3-5** are rejected under 35 USC §112, first paragraph, as failing to comply with the enablement requirement.

The Examiner asserted that the “claim language fails to establish the relation between the first and second gaming device/feature in terms of game play, location, etc. therefore providing an unclear scope of the claims.” (Office Action, page 2).

As Applicants argued in response to the previous Office Action, from which Office Action this rejection is maintained, it is clear from the plain language of the claim that the first feature is related to the second feature as being other than the second feature. Likewise, the first gaming device is related to the second gaming device as being other than the second gaming device. Applicants fail to understand how this claim language can possibly be so unclear as to render one of ordinary skill in the art unable to make or use the claimed embodiments. The Office has failed to provide any

argument to substantiate this rejection, even in response to Applicants previously submitted arguments. Applicants once again request reconsideration of this rejection.

2. Claim Rejections – 35 USC §102

Claims 34-38 under 35 USC §102(b) as being anticipated by Rowe (US 7,162,036 B2) (hereinafter, “Rowe”). Applicants respectfully traverse this rejection for the reasons set forth below.

Applicants respectfully submit that Rowe does not teach or suggest the following elements of claim **34**:

- *accumulating data relating to usage of at least one feature of a gaming device; and*
- *generating an authentication code based on the data.*

The Office’s premise in this rejection appears to be that because the Office views no distinction in different types of data that may be part of a data object of an application, the Office is not giving any patentable weight to the limitation “relating to usage of at least one feature of a gaming device.” Applicants respectfully request that the Office reconsider its position. If the Office’s position were to be final, the initial invention or disclosure of a manipulation of a first kind of data would prevent the patenting of a method directed towards a manipulation of a completely different type of data. Such a position appears to Applicants to result in a harsh result that runs counter to the public policy of encouraging innovation. Further, Applicants are unaware of any law, regulation or case law that

would allow the Office to essentially ignore a claim limitation in this manner. Applicants respectfully request reconsideration of this rejection and an examination of the claim that includes giving consideration to each claim limitation.

Further, Applicants respectfully submit that since Rowe fails to even describe a feature of a gaming device, much less tracking usage thereof, Rowe fails to enable the claimed embodiment. As is well established, a reference must be enabling in order to server as a proper 102(b) reference.

Applicant note that claim **34** has been amended herein for reasons unrelated to this rejection. Specifically, Applicants have amended claim **34** in light of recent case law regarding method claims and statutory subject matter.

With regards to claim **35**, Applicants respectfully submit that Rowe does not teach the following elements of claim **35**:

- *receiving data relating to usage of at least one feature of a gaming device; and*
- *receiving an authentication code based on the data.*

Applicants note that these elements are similar to those discussed above with reference to claim **34** and, for the reasons discussed above, are likewise patentable over Rowe. Applicants further note that all of claims **35-37** depend upon claim **35** and incorporate all of the elements and limitations of claim **35**. As a result, for the reasons discussed above, claims **35-37** are patentable at least for the same reasons as claim **35**.

With regards to claim **38**, Applicants submit that Rowe does not teach the following element of claim **38**:

- *receiving data relating to usage of at least one feature of a gaming device.*

Applicants respectfully submit that this feature is similar enough to the feature argued with respect to claim **34**, and the Office's reasons for rejecting this claim in view of Rowe are essentially the same as those discussed with respect to claim **34**, that Applicants' arguments with respect to claim **34** are applicable to claim **38** as well. Applicants respectfully request reconsideration of this rejection for the same reasons as set forth for claim **34**.

3. Claim Rejections – 35 USC §103

Claims **2-9 and 18-19** under 35 USC §103(a) as allegedly being unpatentable over Acres (US 6,375,567 B1)(hereinafter, "Acres") in view of Rowe.

Applicants respectfully submit that Acres does not teach the following elements of claim **2**:

- *determining a measure of profitability of the first gaming device;*
- *determining a difference between the measure of profitability and a benchmark measure of profitability;*

- *determining whether to disable the first feature based on the difference;*
- *generating an authentication code based on the use of the first gaming device while the first feature is enabled for use on the first gaming device; and*
- *outputting the authentication code if the first feature should be disabled based on the difference.*

Applicants respectfully disagree with the Office's interpretation of Acres. For example, at Acres: col. 10, lines 39-40, does not teach, as the Office asserts "a means to determine the results of the secondary game". Rather, Acres clearly states "then the player is deemed ineligible to win the bonus award from the outcome of the **tertiary** game". (emphasis added). Further, Applicants respectfully submit that the rates described in Acres do not qualify as or equate to a measure of profitability. To take but one example, measuring the rate of play of a player does not provide a measure of profitability of a gaming device. Is the player receiving a winning outcome more often than average? Less often? More information is needed to determine profitability. Quite simply, a teaching of measuring a rate of play by Acres does not teach *determining a measure of profitability of the first gaming device* as claimed. Likewise, measuring total coins played or maximum bet does not teach this element of claim 2.

Furthermore, assuming, arguendo, that determining a player's rate of play is above a predefined threshold teaches determining a difference between two things, as discussed above, it is not a teaching of *determining a difference between the measure of profitability and a benchmark measure of profitability* as claimed. As a result, it is evident that Acres does not teach

determining a measure of profitability of the first gaming device let alone determining a difference between the measure of profitability and a benchmark measure of profitability.

Applicants further respectfully assert that Rowe does not teach *generating an authentication code based on the use of the first gaming device* as claimed. At the Examiner's citation to Rowe: col. 9, lines 20-28, the following is stated:

FIG. 5 is a flowchart 500 illustrating an exemplary process by which a previously generated gaming application signature is used to authenticate a corresponding gaming application deployed in the field. In response to a visit by a gaming industry regulator to a gaming establishment, access to the establishment's gaming application server (e.g., server 124 of FIG. 1C) is typically provided for the purpose of verifying compliance with the applicable gaming regulations (502). This access may be direct, i.e., via the network administrator's terminal, or indirect, e.g., via a particular gaming machine or other node on the establishment's gaming network.

Later, at col. 9, lines 50-60 Rowe teaches:

An object signature is generated for each of the retrieved objects according to one or more of a variety of techniques as described above (508). The generated object signatures are then combined to form a signature corresponding to the deployed gaming application (510). As mentioned above, this may be achieved using any of a wide variety of conventional and proprietary techniques.

The deployed gaming application signature is then compared to the previously stored original gaming application signature which corresponds to the version of the game certified by the gaming commission (512).

As is evident, Rowe teaches generating a signature for a gaming application and subsequent certification of the gaming application by comparing a previously stored signature with a signature generated by a regulator with access to the gaming machine. Quite simply, Rowe nowhere teaches, at the Examiner's citations or elsewhere, *generating an authentication code based on the use of the first gaming device*, much less based on such use *while the first feature is enabled for use on the first gaming device* as claimed.

It is therefore evident that Acres and Rowe individually fail to teach or otherwise suggest numerous elements of claim 2. As a result, the combination of Acres and Rowe, such a combination neither suggested nor deemed appropriate, likewise fails to teach numerous elements of claim 2. As a result, claim 2 is in condition for allowance.

With regards to claims 3-9, Applicants note that all of claims 3-9 depend upon claim 2 and incorporate all of the elements and limitations of claim 2. As a result, for the reasons discussed above, claims 3-9 are in condition for allowance.

Applicants further note that the Examiner, referring to the 35 USC §112 rejections of claims 3-5 (discussed above), asserted that "Since the claim language is unclear, for now the Examiner views no difference between a first and second feature." (Office Action, page 4). Applicants merely reassert, as discussed above, that the rejections of claims 3-5 under 35 USC §112 are improper and request substantive examination of all of claims 3-9.

With regards to claims **18 and 19**, the Examiner asserted that “the data collected by the gaming machine is a means to determine a level of profitability of an EGM and player for the casino establishment (Acres: col. 5, lines 4-12). Therefore every player’s game lose equates to more money for the casino and the prior art establishes rate of return for the casino based on the player’s wager, rate of play & coin-in deposited criteria being met (Acres: col. 6, lines 56-57). (Office Action, page 4).

As discussed above, both Acres and Rowe fail to teach or otherwise disclose *determining a code based on the measure of performance of the feature* as recited in claim **18**. As a result, claim **18** is in condition for allowance. Further, as claim **19** depends upon independent claim **18** and recites all of the elements and limitations of claim **18**, claim **19** is likewise in condition for allowance.

4. Claim Rejections – 35 USC §103

Claims **10 and 20-33** under 35 USC §103(a) as allegedly being unpatentable over Acres in view of Rowe and Acres (US 2001/0055990 A1)(hereinafter, “Acres ‘990”). Applicants respectfully traverse this rejection.

With regards to claim **10**, the Examiner asserted that Acres ‘990 teaches “configuring a pay table based on the rate of usage at the EGM ([Acres ‘990]: par 37, lines 6-10).” (Office Action, page 5).

Applicants note that claim **10** recites *determining a payout table in accordance with the first feature*. However, as discussed above, the Examiner interpreted making a player eligible to win a bonus award as corresponding to *enabling a first feature for use on a first gaming device* as recited in claim **2** (upon which claim **10** depends). Therefore, assuming,

arguendo, the Examiner is correct in paraphrasing the teachings of Acres '990 as teaching configuring a pay table based on the rate of usage at an EGM, Acres '990 would not teach configuring or otherwise determining a payout table *in accordance with the first feature* as claimed. In addition, as claim **10** depends upon independent claim **2** and recites all of the elements and limitations of claim **2**, and, as Acres '990 does not remedy the deficiencies of Acres and Rowe discussed above with respect to claim **2**, claim **10** is likewise in condition for allowance for the reasons discussed above with reference to claim **2**. For all of these reasons, claim **10** is in condition for allowance.

With regards to claim **20-33**, Applicants respectfully note that all of claims **20-33** depend upon claim **18** and recite all of the elements and limitations of claim **18**, and, as Acres '990 does not remedy the deficiencies of Acres and Rowe discussed above with respect to claim **18**, claims **20-33** are likewise in condition for allowance for the reasons discussed above with reference to claim **18**.

Applicants note that each of the independent claims have been amended herein for reasons unrelated to the outstanding rejections. Rather, the independent claims have been amended herein to address certain developments in case law regarding method claims and statutory subject matter.

Further, Applicants note that the independent claims added herein correspond substantially to the method claims already examined but are addressed to different statutory classes. No new matter is believed added by this amendment.

Conclusion

At least for the foregoing reasons, it is submitted that all claims are now in condition for allowance, or in better form for appeal, and the Examiner's early re-examination and reconsideration are respectfully requested.

Alternatively, if there remain any questions regarding the present application or the cited reference, or if the Examiner has any further suggestions for expediting allowance of the present application, the Examiner is cordially requested to contact Magdalena M. Fincham via the contact information provided below.

Authorization to Charge Fees

Applicants believe that a two month extension of time is required to make this Amendment and Response timely and is filed herewith. Accordingly, please grant a petition for a two month extension of time necessary to make this submission timely. Additionally, please charge any fees required for this submission, including a two month extension of time fee, the RCE fee and the excess claim fee as follows:

Deposit Account: 50-0271

Order No. 02-034

Charge any additional fees or credit any overpayment to the same account.

Respectfully submitted,

May 08, 2009

Date

/Magdalena M. Fincham, 46,085/

Magdalena M. Fincham
Attorney for Applicants
Registration No. 46,085
mfincham@walkerdigital.com
(203) 461-7041/ voice
(203) 461-7300/fax